

DETAILED ACTION

Information Disclosure Statement after Notice of Allowance

The information disclosure statement (IDS) received on October 21, 2008 and comprising one page of references was filed after the mailing date of the Notice of Allowance on September 19, 2008. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

The information disclosure statement (IDS) received on October 21, 2008 and comprising six pages of references was filed after the mailing date of the Notice of Allowance on September 19, 2008. The submission is NOT in compliance with the provisions of 37 CFR 1.97 as section V of MPEP § 609.04(b) states the following, emphasis added, with respect to 37 CFR 1.97(e):

In the alternative, a statement can be made if no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person signing the statement after making reasonable inquiry, neither was it known to any individual having a duty to disclose more than 3 months prior to the filing of the statement. If an inventor of the U.S. application is also a named inventor of one of the items of information contained in the IDS, the 37 CFR 1.97(e)(2) statement cannot be made for that particular item of information, and if made, will not be accepted.

The phrase "after making reasonable inquiry" makes it clear that the individual making the statement has a duty to make reasonable inquiry regarding the facts that are being stated. The statement can be made by a registered practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A registered

practitioner who receives information from a client without being informed whether the information was known for more than 3 months, however, cannot make the statement under 37 CFR 1.97(e)(2) without making reasonable inquiry. For example, if an inventor gave a publication to the attorney prosecuting an application with the intent that it be cited to the Office, the attorney should inquire as to when that inventor became aware of the publication and should not submit a statement under 37 CFR 1.97(e)(2) to the Office until a satisfactory response is received. The statement can be based on present, good faith knowledge about when information became known without a search of files being made.

Therefore, in view of the late stage of prosecution and the common inventors between the instant application and the cited references, said cited references listed will not be considered.

/Vanessa Velasquez/

Examiner, Art Unit 1793

/Roy King/

Supervisory Patent Examiner, Art Unit 1793